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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,331	07/01/2004	David S Bonalle	70655.2900	4330
20322	7590	05/03/2006	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 85004-2202			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/710,331

Applicant(s)

BONALLE ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 29 August 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 22 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for primary and secondary association of one user does not reasonably provide enablement for primary and secondary association with separate users. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification teaches that one user can provide different samples to the system for primary and secondary association (overdraft protection) where the samples are from a same user, not from separate users as claimed in claim 22.

Appropriate correction is request.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear to the Examiner how the proffered biometric sample is associated with a transaction limitation independent of a financial account limitation. As the biometric is associated the account, that has a transaction limitation, it is unclear how the transaction limitation of the biometric can be independent from one of the card, especially since claim 20 recites that the transaction limitation associated with the biometric is associated with a transaction limitation of the card.

For purposes of Examination, the Examiner has interpreted the claims to mean that a biometric has a limitation associated with it, and the card/account has a limitation associated with it, such as a total credit limit, which is conventional in the art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-2 and 4-7, 9-15, 18, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as cited in the previous Office Action, in view of Baer (US 2005/0232471)

Re claim 1, Black teaches a biometric sensor to detect a proffered biometric sample a device configured to associate the proffered biometric sample with user information and smartcard information to create a data packet, wherein the sample is associated with an account including at least one of a charge account, credit card account, debit card account, savings account, private label account, PayPal account, membership account, Western Union Account, electronic bill payment account, automatic bill payment account, and loyalty account, and a storing a data packet either locally or remotely (FIG. 1A, 1C, abstract, 5A, 10A-11B, 14A-14B, paragraph [0090]+, and paragraph [0014]+). The Examiner has interpreted the information and biometric to constitute a data packet. As Black teaches the information can be stored remotely or locally, the examiner notes it would have been obvious to store the information in a database, since a database is well known and conventional in the art to conveniently storing and organizing data for easy access. As the information (data packet) is part of the authentication/registration process, it would obviously communicate with the system as part of the process.

Black is silent to the biometric being associated with a preset transaction limitations independent of a financial account limitation.

Baer teaches such limitations (paragraph [0037] +).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Baer.

One would have been motivated to do this to have different levels of security.

Re claim 2, the Examiner notes that Black teaches that the biometric is stored either on the smartcard/transponder or remotely. Accordingly, it would have been obvious to store, process, and verify the sample as part of the process to associate and authenticate/verify the sample, as is conventional in the art.

Re claim 4, it has been discussed above that users accounts and biometrics are associated. The Examiner notes that it is obvious that different biometric samples (from different users) can be associated with different accounts. It would have been obvious to do this in order to have a system that many different people can use. As different people have different samples and accounts, it would have been obvious that each sample is associated with a different account in order to have a secure system.

Re claim 5, it has been discussed above that the data packet can be stored on a database. The Examiner notes that Black teaches that the stored information includes at least one of a sample, user information, terrorist information, and criminal information (FIG. 10A+ and FIG. 14A+ which teach user records). The storing of such information on a database is an obvious expedient to facilitate organizing and efficient data storage.

Re claim 6, it has been discussed above that the data packet can be stored locally or remotely. Accordingly, it would have been obvious to one of ordinary skill in the art that remote/local storing would include one of a remote server, merchant server, smartcard system, smartcard reader, sensor, and smartcard itself. One would have been motivated to store it accordingly, based on desired security concerns.

Re claim 7, when stored remotely, the Examiner notes it would have been obvious that the database be operated by an authorized sample receiver, in order to ensure security.

Re claims 9-11, the Examiner notes it would have been obvious to have different samples for different users associated with information to have a system that can be used by more than one person.

Re claim 12, the Examiner notes that secondary security procedures to facilitate verification of a proffered sample are well known and conventional in the art (in order to determine that a sample is a real sample, for example). One would have been motivated to verify the sample, in order to ensure that it is real (security reasons). It would have been obvious for the device that associates the information to perform the procedure, as part of the process to register samples and user information.

Re claim 13, Black teaches that a unique identifier/customer number is associated with the user (FIG. 10A+). This is broadly interpreted as a personal identification number, or a unique means to verify a user/device. Additionally, the Examiner notes PIN-biometric combinations are well known and conventional in the art for increased security in systems. Therefore, using a PIN in addition to a biometric is an obvious expedient to increase security. The Examiner also notes that de Sylva teaches that prior art systems use biometric and PINs for

access (paragraph [0013]). It is obvious that the device that associates would perform such steps, as they are integral to the process of registering and storing data.

Re claim 14, it has been discussed above that a fingerprint sample is obtained. It would have been obvious that a fingerprint be scanned, in order to obtain the fingerprint data to facilitate authentication/registration.

Re claim 15, Baer, as discussed above, teaches that the preset transaction limitation is associated with an account, for purchasing.

Re claim 18, as discussed above, a maximum amount transaction limitation has been taught by Baer above.

Re claim 20, Baer teaches associating the limit with a card account, as discussed above.

Re claim 21, as Black teaches remote or local storing, the Examiner notes it would have been obvious to store the biometrics by a third party security vendor or government agency to ensure security.

5. Claim 8-11, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer, as discussed above, in view of de Sylva (US 20050098621).

The teachings of Black/Baer have been discussed above.

Black/Baer are silent to primarily associating the biometric with first user information and secondarily associating it with second user information.

De Sylva teaches that one biometric sample is required and that one sample is associated with different accounts based on a relationship established by the user record (30).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of de Sylva.

One would have been motivated to do this in order to have only one sample required for access, thus still maintaining security, but allowing a user to establish a relationship for multiple account usage (convenience/personalization).

Re claims 9-11, the Examiner notes it would have been obvious to have different samples for different users associated with information to have a system that can be used by more than one person.

Re claim 17, the Examiner notes that it has been discussed above that selection of accounts is made based along criteria set forth. Accordingly, it would have been obvious to have a device facilitate selection of the account, in accordance with the rules, in order for charges to automatically be made to comply with the rules (processor, controller, etc). Additionally, the Examiner notes that consolidated cards, which store multiple accounts from which a user can select a particular account to use for a transaction, are also well known in the art for convenience. The use of a biometric as a security precaution for such cards is an obvious expedient.

Re claim 19, the Examiner notes that de Sylva teaches that the biometric is associated with at least two accounts, as discussed above.

6. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer, as discussed above, in view of Moebs et al. (US 2005/0065872).

The teachings of Black/Baer have been discussed above.

Black/Baer are silent to primarily associating the biometric with first user information and secondarily associating it with second user information.

Moebs et al. teaches secondarily associating with a biometric (paragraph [0017]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Moebs et al.

One would have been motivated to do this in order to have overdraft protection.

Re claims 9-11, as discussed above, it would have been obvious to one of ordinary skill in the art to associate different samples with different information in instances where there are multiple users of the system, for unique identification. The use of many samples has been discussed above, as well.

Additional Remarks

7. Re claim 15, de Sylva et al. teaches that a user can specify that transactions greater than a certain amount be charged to certain accounts while smaller purchases are charged to a different account (paragraph [0047]). Therefore it would have been obvious to have a preset amount for an account to control charges.

The Examiner notes that different levels of security are well know and conventional in the art. For example, Deo et al. (US 5,721,781) teaches based on transaction amounts, different information is required in order to provide security/assurance that the user is valid (see Fig. 9), Rasmussen et al. (US 6,834,795) teaches similar teachings (FIG. 5), de Sylva (US 2005/0098621) teaches association (primary and secondary), Moebs et al. (US 2005/0065872) teaches overdraft protection through linking accounts, and Tetro et al. (US 6,095,413) teaches added security trough use of a separate databases).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Deo et al. (US 5,721,781), Rasmussen et al. (US 6,834,795), and Tetro et al.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876

4-23-06

